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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,411	07/08/2004	Irving Solomon	8868.4811	4410
22235	7590	04/19/2006	EXAMINER	
MALIN HALEY AND DIMAGGIO, PA 1936 S ANDREWS AVENUE FORT LAUDERDALE, FL 33316			ABBOTT, YVONNE RENEE	
			ART UNIT	PAPER NUMBER
			3644	

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b><i>Office Action Summary</i></b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/710,411	SOLOMON, IRVING
	Examiner Yvonne R. Abbott	Art Unit 3644

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-21 and 38-45 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-11, 38, 40-45 is/are rejected.

7)  Claim(s) 12-21 and 39 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date .  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 1/26/06 have been fully considered but they are not persuasive.
2. Applicant argues that the "layered means element of claim 1 must be construed to cover the corresponding structure and material described in the specification and equivalents thereof" according to 35 U.S.C. 112, sixth paragraph. Applicant further asserts that in referring to the specification, Applicant discloses that the layered means of claim 1 comprises preferably "a plastic outer layer 40, a superabsorbent layer containing superabsorbent material such as cross-linked sodium polyacrylate 42, and a soft layer 44"; and Applicant also discloses that "the superabsorbent polyacrylate layer preferably lies between an upper means for storing liquid 46 and an outer means for storing liquid 48, such as cellulose or an equivalent material." "Finally, Applicant discloses that the superabsorbent material is included in the diaper preferably in elongated channels through the bottom portion of said diaper which are oval-shaped in cross-section." With respect to Applicant's argument, it should be noted that a claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:
  - (A) the claim limitations must use the phrase "means for " or "step for; "
  - (B) the "means for " or "step for " must be modified by functional language; and

(C) the phrase "means for " or "step for " must not be modified by sufficient structure, material or acts for achieving the specified function.

With respect to the third prong of this analysis, see *Seal-Flex*, 172 F.3d at 849, 50 USPQ2d at 1234 (Radar, J., concurring) ("Even when a claim element uses language that generally falls under the step-plus-function format, however, 112 ¶ 6 still does not apply when the claim limitation itself recites sufficient acts for performing the specified function."). In the instant case, claim 1 recites "*layered* means for absorbing". Because the claim describes the structure supporting the absorbing function (i.e. layered), the phrase is considered not to invoke 35 U.S.C. 112, sixth paragraph. Also note *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531, 41 USPQ2d 1001, 1006 (Fed. Cir. 1996) (holding "perforation means...for tearing" does not invoke 35 U.S.C. 112, sixth paragraph, because the claim describes the structure supporting the tearing function (i.e., perforation). Applicant has the opportunity and the obligation to define their invention precisely, including whether a claim limitation invokes 35 U.S.C. 112, sixth paragraph. Thus, if the phrase "means for" or "step for" is modified by sufficient structure, material or acts for achieving the specified function, the USPTO will not apply 35 U.S.C. 112, sixth paragraph, until such modifying language is deleted from the claim limitation. As such, the means-plus- function limitation as presently recited will be given the broadest reasonable interpretation (i.e. a layered means for absorbing).

3. It should be noted also that Applicant originally claimed (claim 1, lines 4-6) a bottom portion *comprising* means for attaching, and layered means for absorbing, and

by now deleting “comprising” in the body of the claim, the scope of the invention has changed. However, some of the previously applied art, still reads on the invention as presently claimed. Further, with respect to Applicant’s arguments regarding the prior art being intended for use on a human, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. All the previously applied prior art have the application and use of absorbing liquid while secured to a user.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,2, 4, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohta (5,954,015). Ohta shows a one-piece diaper capable of being worn on a pet comprising a lightweight upper portion (6) and an absorbent bottom portion (2), means (8,9) for securely attaching the diaper to the pet; and layered means (3) for absorbing generally liquid discharge of the pet, whereby the diaper closely conforms to the contours of the pet's body; wherein the means for attaching comprises an elongated

strip (9) on each side of the upper portion; further comprising means for holding the diaper around the pet's tail (40).

6. Claims 1, 3, 4, 5, 6, 7, 8, 9, 10, 38, and 40-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelly (5,555,847). Kelly shows a diaper capable of being worn on a pet comprising a lightweight upper portion, an absorbent bottom portion, means (47) for securely attaching the diaper to the pet; layered means (i.e. sponge or padding material) for absorbing generally liquid discharge of the pet, whereby the diaper closely conforms to the contours of the pet's body; wherein the means for attaching comprises left and right slits (see Figures 2,3,5) on a bottom portion of the diaper; and the means for attaching comprises a detachable elongated strip (56,76) on each side of the upper portion; wherein the strips (76) on an upper portion are passable through corresponding slits (83) on a bottom portion; further comprising an aperture as means for holding the diaper around the pet's tail; wherein the strips (76) are capable of being fastened together; wherein the upper portion comprises a soft layer and a layer of polyethylene (col. 2, lines 50-64); and wherein the strips are capable of passing through diagonally opposing slits.

7. Claims 1, 2, 4, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Lowman (5,234,421). Lowman shows a one-piece diaper capable of being worn on a pet comprising a lightweight upper portion (38) and an absorbent bottom portion (36), means for securely attaching the diaper to the pet; and layered means (multiple plies) for absorbing generally liquid discharge of the pet, whereby the diaper closely conforms

to the contours of the pet's body; and the means for attaching comprises an elongated strip (30,32) on each side of the upper portion; and means for holding the diaper around the pet's tail (14).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta in view of Igaue et al. (5,114,420). Although Ohta discloses an animal diaper having an absorbent bottom portion, it is not specifically disclosed that the bottom portion is at least partially rigid. Igaue et al. teach a diaper having an at least partially rigid absorbent section (13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide that the absorbent layer of Ohta was rigid according to the teaching of Igaue et al. in order to give the diaper structural stability.

***Allowable Subject Matter***

10. Claims 12-21, 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne R. Abbott whose telephone number is (571) 272-6896. The examiner can normally be reached on Monday-Thursday 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on (571) 272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yvonne R. Abbott  
Primary Examiner  
Art Unit 3644